REMARKS

The Specification has been amended to include SEQ ID Nos. The Examiner has requested the submission of the typed Abstract instead of a photocopy of the first page of the international application. The Applicant wishes to point the Examiner's attention to the Preliminary Amendment filed January 10, 2001, which included the typed version of the Abstract. However, as a courtesy to the Examiner, a new copy of the typed Abstract is enclosed with this Amendment. Claims 1, 2, 4-6, 11, and 24 have been amended. New Claim 27 has been added. Support for the amendments can be found in the Specification and claims as originally filed. No new matter has been introduced herewith. Claims 3 and 22 have been canceled. The following addresses the substance of the Office Action.

Oath/Declaration

The Examiner has requested a new oath or declaration in compliance with 37 CFR 1.67(a) to submitted. The oath/declaration as filed was found defective because the corrections made in the address of one of the inventors were not initialed by the person making the corrections, and because the first name of one of the inventors was not spelled out. Due to the logistics of obtaining the signed Declaration from the overseas inventor, Applicant will provide a new oath/declaration shortly.

Specification

The Examiner has objected to the abstract of the disclosure as being a photocopy of the first page of the International Publication. Applicant wishes to point the Examiner's attention to the Preliminary Amendment filed January 10, 2001, which included the typed version of the Abstract (see copy attached herewith obtained from electronic file wrapper of the application). However, as a courtesy to the Examiner, a new copy of the typed Abstract is enclosed in this Amendment.

The Examiner has objected to the Specification for failing properly identify amino acid and nucleic acid sequences contained on pages 8-10 of the Specification as filed. The Applicant has amended the Specification to include the required SEQ ID Nos.

The Examiner has objected to the amendment filed October 2, 2003 for wrongly indicating a correction on page 11, lines 16-20, where the correction should have been made on page 12, lines 16-20. Applicant has amended the Specification on page 12, lines 16-20.

Claim objections

The Examiner has objected to Claim 1 for reciting an acronym (TGB-3) without first spelling out the acronym. Applicant has amended the Claim 1 to recite "triple gene block 3 (TGB-3)". Support for the amendment can be found in the Specification as filed, page 4, lines 10-11.

The Examiner has objected to Claim 2 for reciting an acronym (BNYVV) without first spelling out the acronym. Applicant has amended Claim 2 to now recite " beet necrotic yellow vein virus (BNYVV)". Support for the amendment can be found in the Specification as filed, page 1, line 25.

The Examiner has objected to Claims 4, 14-22 and 26 for reciting non-elected subject matter of SEQ ID NO: 1 and 5. Applicant has amended Claim 4 by removing references to SEQ ID Nos 1 and 5. Claims 14-22 and 26 depend on claim 4, but themselves do not recite SEQ ID Nos 1 and 5, and therefore did not need to be amended.

Claim 11 has been objected to for reciting "foreigner promoter". Applicant has amended claim 11 to now recite "foreign promoter".

Claim rejections under 35 U.S.C. §112

The Examiner has rejected Claims 3, 5-13 and 23-25 under 35 U.S.C. §112, first paragraph as failing to provide enablement for genetically modified TGB-3 viral sequences other than SEQ ID NO: 3. More specifically, the Examiner asserts that the invention is only enabled for the elected SEQ ID NO: 3, and its ability to confer resistance to a furovirus in a plant cell. However, according to the Examiner, the invention is not enabled for any genetically modified TGB-3 viral sequence which has the ability to induce resistance to any virus in a plant cell. Applicant maintains that the specification is enabling for sequences other than SEQ ID NO: 3 but, solely for expediting the allowance of the present application, Applicant has canceled Claim 3 and amended Claim 4 to recite only SEQ ID NO: 3. Accordingly, Applicant maintains that the previous rejection of Claims 5-13 and 23-25 is now moot and should be withdrawn. Applicants reserve full rights to pursue claims directed to sequences other than SEQ ID NO: 3 in related applications.

The Examiner has rejected Claims 1,2, 6-13, 22, 24 and 25 under 35 U.S.C. §112, second paragraph for being indefinite. More specifically, Claims 1 and 2 have been rejected for failing to recite a positive process step that refers back to the preamble of the claim. Applicant has

amended Claim 1 to address the Examiner's concern. Applicant maintains that the amendment of Claim 1 does not narrow its scope.

Claims 6-13, 24 and 25 have been rejected for failing to recite a positive process step that refers back to the preamble of the claim. Applicant has amended Claim 6 to now recite the step of "thereby inducing resistance to a virus in a plant or plant cell". Applicant maintains that the amendment of Claim 6 does not narrow its scope.

Claim 22 has been rejected for use of the unclear term "reproducible structure". Applicant has canceled Claim 22, rendering this rejection moot.

Claim 24 has been rejected for referring to "the method of Claim 5", while claim 5 is not directed to a method. Applicant has amended claim 24 to depend on Claim 6, which is directed to a method. Accordingly, Applicant maintains that this rejection is now moot.

Applicant respectfully requests that the rejections of claims 1, 2, 6-13, 22, 24 and 25 under 35 U.S.C. §112, second paragraph be withdrawn.

Double Patenting

Claims 6-21, 25 and 26 have been rejected under judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 3-5, 7-11, 13, 14, 16-20, 23 and 24 of US Patent No. 6,297,428. More specifically, the Examiner indicated that claims 6-21, 25 and 26 of the instant application are generic claims that are anticipated by specific claims of the US Patent No. 6,297,428.

Applicants respectfully disagree. Claims 6-21, 25 and 26 of the instant application are directed to a method of inducing resistance to a virus comprising preparing a construct comprising a genetically modified TGB-3 sequence of SEQ ID NO: 3. The generic Claim 1 of the US Patent No. 6,297,428 is directed to a method of inducing resistance to a furovirus comprising preparing a construct comprising a nucleic acid corresponding to a TGB-3 sequence or its deletion mutant. SEQ ID NO: 3 is not obvious over a generic TGB-3 sequence or its deletion mutant. Therefore, Claims 6-21, 25 and 26 of the instant application are not obvious over 1, 3-5, 7-11, 13, 14, 16-20, 23 and 24 of US Patent No. 6,297,428, and withdrawal of the rejection of Claims 6-21, 25 and 26 under judicially created doctrine of obviousness-type double patenting is respectfully requested.

For all of the above reasons, Applicants respectfully request withdrawal of all rejections and allowance of the pending application.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 16, 2004

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